

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/730,549

Examiner

Lora E. Barnhart

Applicant(s)

LAUGHLIN ET AL.

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 15 October 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☒ 2. Abstract:
- ☒ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☒ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: See continuation sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

CONTINUATION SHEET***PTOL-324 Notice of Noncompliant Amendment***

Continuation of Box 4. The amendments to the claims cause the amendment document received 10/15/07 to be noncompliant because the claims have not been labeled with proper status identifiers. As noted in the final rejection mailed 4/11/07, claims 42, 43, and 49-53 were considered on their merits; they have not been withdrawn by the examiner, as the claim listing submitted after final rejection would indicate. Claims 43 and 49-53 should be marked "previously presented," while claim 42 should be marked "original."

PTOL-303 Advisory Action Before the Filing of an Appeal Brief

Continuation of Box 11. The request for reconsideration has been fully considered, but it does NOT place the application in condition for allowance because applicant's arguments do not overcome all of the rejections of record. The objections to the specification and drawings are overcome by the reply. As noted in box 5 of the advisory action, the rejections of record under 35 U.S.C. § 112, first and second paragraphs, have been overcome by the amendments to the claims and applicant's comments.

The rejection under 35 U.S.C. § 103, however, stands. Regarding this rejection of record, applicants allege that the person of ordinary skill in the art would not have been motivated to combine the references as the examiner suggests (Reply, page 15, paragraph 1). Specifically, applicants allege that the prior art does not teach or suggest purifying CD133+/CD34+ cells (Reply, page 15, paragraphs 2 and 3). These arguments have been fully considered, but they are not persuasive.

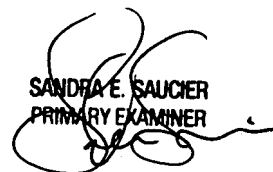
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The **claims** are drawn to methods of treating ischemic tissue by administering CD133+ cells to a subject in need thereof; the **claims** make no mention of the expression of CD34. It is noted that the instant disclosure discusses CD133+/CD34+ cells, but there is no requirement in the **claims** for the expression of CD34. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's allegation that the claimed invention is not obvious in view of the cited prior art because the instant disclosure was the first to identify the role of CD133+ cells in myocardial repair is insufficient to overcome the rejection. The examiner set forth a *prima facie* case of obviousness. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SANDRA E. SAUCHER
PRIMARY EXAMINER